

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1 and 11 have been amended and new claim 12 has been added. Thus, claims 1-12 are currently pending in the application and subject to examination.

In the Office Action mailed March 12, 2004, the Examiner rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,564,190 to Dubner in view of U.S. Patent No. 6,003,018 to Michaud, and further in view of U.S. Patent No. 6,411,936 to Sanders. It is noted that claims 1 and 11 have been amended. The Applicant hereby traverses the rejection, as follows.

### **Rejection Under 35 U.S.C. § 103(a)**

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubner in view of Michaud, and further in view of Sanders. In making this rejection, the Examiner appears to assert that solutions of Sanders are equivalent to the sets of evaluation values (data sets) of the present invention. However, the solutions of Sanders do not have an attribute representing a condition of the evaluation, as recited in claim 1 of the present invention.

Applicants submit that neither Sanders nor any other the other cited art suggests or discloses at least the limitation of "an attribute representing a condition of the evaluation," as claimed in claim 1.

Furthermore, Applicants note that claim 1 has been amended to further distinguish how the sets of evaluation values of the present invention differ from the solutions of Sanders. In particular, claim 1 has been amended to add the limitation "said set of evaluation values further having different values on a first evaluation factor axis and having the same values on all other axes," as described, for example, on page 18, lines 12-15 of the specification. Neither Sanders nor any of the other cited art suggests or discloses at least the limitation of "said set of evaluation values further having different values on a first evaluation factor axis and having the same values on all other axes," as recited in claim 1, as amended.

For at least these reasons, Applicants submit that claim 1, as amended, is allowable over the cited prior art. As claim 1, is allowable, Applicants submit that claims 2-10, which depend from allowable claim 1, are likewise allowable over the cited prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 103(a).

Furthermore, regarding claim 4, Applicants note that none of the cited references teaches and/or suggests that the database contains elements that have a relationship of a layered structure, as recited in claim 4. This element provides the "drill down" or "roll up" functionality of the present invention, which are not found in the cited art. For this reason, Applicants further submit that claim 4 is patentable over the art of record.

Also, similarly to as discussed above with regard to claim 1, Applicants submit that claim 11, as amended, is allowable over the cited prior art at least because the cited prior art does not disclose or suggest at least the limitation of "said set of evaluation values further having different values on a first evaluation factor axis and

having the same values on all other axes,” as claimed in claim 7, as amended. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a).

New claim 12 has been added to further highlight the distinctive features of the present invention. In particular, new claim 12 describes the layered structure that provides the “drill down” or “roll up” aspects of the present invention, which are not found in the cited art. As discussed above in reference to claim 4, Applicants note that none of the cited references teaches and/or suggests that the database contains elements that have a relationship of a layered structure, as recited in new claim 12. For this reason, Applicants further submit that new claim 12 is patentable over the art of record.

#### **Rejection Under 35 U.S.C. §101**

Claim 11 further stands rejected under 35 U.S.C. §101 for failing to provide a concrete, useful and tangible output. This rejection is respectfully traversed for the following reasons. The Court of Appeals for the Federal Circuit has held that the subject matter of a claim is statutory if it “produces a ‘useful, concrete and tangible result,’...even if the result is expressed in numbers.” In particular, the court held that “the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, because it produces ‘a useful, concrete, and tangible result.’” In re State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 47 U.S.P.Q.2d 1600, 1602 (Fed. Cir. 1998).

Claim 11 of the present invention is directed to an article of manufacture that causes the transformation of data by a machine through a series of mathematical calculations. Numerical data are transformed into coordinates, expressed as numbers, and image data showing an object are output. The image data showing an object are useful in business portfolio planning. Therefore, the article of manufacture of claim 11 produces a useful, concrete, and tangible result, namely, image data showing an object, and is therefore statutory subject matter. Accordingly, claim 11 is patentable under 35 U.S.C. §101, and Applicants respectfully request reconsideration and withdrawal of the rejection.

### **Conclusion**

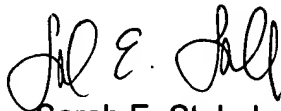
For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referencing Attorney Docket No. 024201-00001.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read "Sarah E. Stahnke".

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